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EXAMINER

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ART UNIT PAPER NUMBER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 36

Application Number: 09/476,319
Filing Date: December 30, 1999
Appellant(s): HASEBE ET AL.

Douglas H. Goldhush, Reg. No. 33,125
Squire, Sanders & Dempsey LLP
Tysons Corner, VA
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 30, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1, 6, 11, 17-19, 23-29, 33-39, 43-49, 53-56, 11-113, 19, 123, 124, and 125 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 101

Claims 1-56 and 111-125 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The instant claims are directed to non-functional descriptive matter. Non-functional descriptive matter is that which exhibits no functional interrelationship, either as part of the stored data or as part of the computing processes performed by the computer, then such descriptive material alone does not impart functionality either to the data as so structured, or to the computer. Such "descriptive material" is not a process, machine, manufacture or composition of matter. The instant claims recite a storage medium with two or three storage areas. However, none of the storage areas provide for descriptive matter that provides for a functionality either to the data as structured or a process to be implemented on a computer. The claims seek to patent a storage medium that is a repository for specific type data, but that data is not functional in nature. The data on the storage medium is solely to be acted on by another process when imparted to a computer.

The original patent application 08/603,760 amended the pending claims by adding to the preamble "accessed by a vendor computer and user computer, said

storage medium""information readable by said user computer, said storage medium" to overcome the 101 non-statutory rejection raised at that time. However, it is not clear that the claims of this reissue application provide for functional descriptive matter, either with claims that still retain the preamble that was originally amended or with the newly added claims that do not have the amendatory language.

(11) Response to Argument

The Final Rejection (paper no. 30) referenced the MPEP guidelines for computer related inventions. The section referred to is 2106, section II, (a). That section includes a reference to *Arrhythmia*. The purpose in referencing this section was to argue that claiming descriptive material on a computer readable medium does not make the invention eligible for patenting if the material is non-functional descriptive material. The argument was to indicate that the claimed invention as a whole must accomplish a practical application that can only result from descriptive material that in some manner is functional in nature. The claimed invention should then seek to impart, i.e. by being embodied on a computer readable medium, that functionality to produce a "useful, concrete and tangible" result to have a practical application.

In analyzing the claimed invention, none of the 40 independent claims (and their 31 dependent claims) recites a step, a series of steps, a process, method, program, instructions, or any other functional descriptive material that would cause or instruct a computer to perform step(s) that are part of a particular process or method to result in a practical application. The data structure of the instant claims is non-functional, in this sense, because it does not set forth any active step(s) of any process or any method.

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None of the limitations in any one of the independent claims is a description of an active step or action to be taken by a computer as part of a process or method.

Nevertheless, even if the descriptive material does not set forth a process or method, or even a step, or steps as part of a process or method, the descriptive material may still be functional. As in *In re Lowry*, 32 USPQ 2d 1031, the functionality of a data structure may lie in its ability to organize stored data or in the management of data to be stored. The data structure of *Lowry* had a functionality that when imparted to a computer resulted in the practical application of organizing stored data in a computer memory in a way that also happened to more efficient and flexible.

However, in the instant case, none of the 40 independent claims recite an invention that, as a whole, is a description of material that is functional in the sense that it may impose a particular organization on a computer system or provide a framework under which the operation of a computer may be improved. The data structure described in the claims is a data structure without a functionality that could be imparted to a computer so as to affect a particular organizing structure, operation or a process of a computer, or in any way result in an improved computer.

The data structure that is recited in each of the independent claims is non-functional because it only describes types of non-functional data and the logical relationship between the various types of non-functional data. However, none of the different types of data that are described is a step, method, or process of encryption. The claimed invention is a storage medium that is readable by a device (read computer) that has two types of data, neither of which is functional. One type of data is an

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encryption key and one other type of data is the encrypted data. None of the different data types described in the claims is an operation, transform, or function.

Applicant argues that the various data on the storage medium interrelate and affect each other, and interrelate with and operate in conjunction with elements of a computer. The relationship between the data types recited in the claims is abstract in nature as it conveys the general proposition that one type of data is an encryption key, while the second data is encrypted data. The only descriptive material that appears to recite functionality in the claimed invention is one describing how one type of data is to be used. Using claim 114 as exemplary (Claim 114 is the shortest and presumable the broadest claim under appeal.), the phrase "wherein the first data is used by the device to decrypt the encrypted data" is an example of such material. Here, neither the first data, nor the encrypted data is functional in nature. The storage medium does not include as one type of data, an encryption method or process which can be imparted to a device so as to instruct or program the device to use the first data to decrypt the other data on the storage medium, e.g. the encrypted data. The claim recognizes that the invention does not provide for such functionality, but rather it is left to the device to be already knowledgeable about how the decryption (or encryption) is to be performed.

The examiner agrees that the data on the storage medium will interrelate and operate with elements of a computer, but merely describing what a computer will do with the data should not warrant ascribing that functionality to the data structure that comprises the storage medium of the invention. The computer is already charged with that functionality. The claimed storage medium does not claim a data structure that

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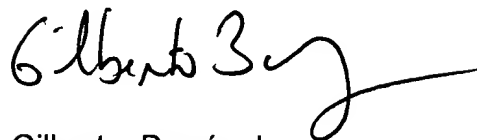
imparts the functionality for instructing a computer on how to use the first data to decrypt the encrypted data. The data structure on the storage medium only provides the data that a computer uses in a process that is already known to the computer and that process is not imparted to the computer from the descriptive material on the storage medium. To argue that a storage medium, that solely provides the raw data on which a computer will use in a process already known to the computer, imparts functionality to a computer is to argue that a CD with music recorded thereon imparts functionality to a computer because the computer will decode the data recorded thereon to result in a musical presentation.

The examiner also agrees with Applicant that an article of manufacture may be statutory. However, when the article of manufacture is merely the carrier for non-functional descriptive material, as in a CD with music recorded thereon, the invention would not pass muster under §101. All of the appealed claims are directed to a storage medium which is comprised of different types of data or has different areas for storing the different types of data. However, none of the data types and none of the data structures resulting therefrom, are functional in nature. Nor can they be shown to impart functionality to a computer when a computer accesses the claimed storage medium simply because that functionality is already charged to the computer.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,



Gilberto Barrón Jr.
Primary Examiner
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gbj
November 26, 2003
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